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| APPLICATION NO.                                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/693,280                                     | 10/23/2003  | David Czeck          | ESP0293               | 4139             |
| 29586  | 7590        | 03/04/2008           | EXAMINER              |                  |
| FSP LLC<br>P.O. BOX 890<br>VANCOUVER, WA 98666 |             |                      | NGUYEN BA, HOANG VU A |                  |
|  |             | ART UNIT             | PAPER NUMBER          |                  |
|  |             | 2623                 |                       |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/693,280             | CZECK, DAVID        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Hoang-Vu A. Nguyen-Ba  | 2623                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 December 2007.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. This action is responsive to the amendment filed December 6, 2007.
2. Claims 1-27 remain pending. Claims 1, 12, 23 and 27 are independent claims.

### ***Response to Amendment***

3. The objection to Claims 24, 25 and 26 is withdrawn in view of Applicant's amendment to these claims to correct the dependency of these claims to the respective base claim. The objection to Claim 25 because of the lack of antecedent basis of the term "advertisement content" is also withdrawn.

### ***Response to Arguments***

4. Applicant's arguments in the Remarks section at pp. 6-7 of the amendment have been fully considered but they are not persuasive. The following is an examiner's response to Applicant's arguments.

With respect to Claims 1, 12, 23 and 27, Applicant essentially submitted that “[i]n Rand material is not overlayed with a still image from the program when the program is paused. There is nothing in Rand about doing this.”

The claims are clear – when a video program is paused, a still image from the program is combined with an ad. This results in a combined image.

Rand doesn't even address combining content with a still image when pausing the video program. Rand doesn't disclose or discuss or even imply how this might be done.”

In response, it is respectfully noted that the claim language does not contain the limitation “overlaid” as submitted by Applicant. Therefore, Applicant’s argument that program material is not overlaid with a still image is moot.

Contrary to Applicant's argument that Rand does not even address combining content with a still image when pausing the video program, the Office action has shown that Rand does disclose this requirement in at least cited paragraphs [0010-0011] and [0028-0032]. According to these paragraphs, Rand's invention relates to the selective insertion of media items (e.g., advertising, passive item) into a media stream. These paragraphs also discuss how Rand's invention is to insert media items (e.g., by halting the delivery of a content – see [0029-0030]).

In view of the foregoing discussion, the rejection of Claims 1-27 under 35 U.S.C. § 102(e) as being anticipated by Rand is considered proper and thus maintained.

***Claim Rejections – 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0226142 by Rand.

### **Claims 1, 12, 23 and 27**

Rand discloses *a method and a system* (see at least FIG. 1) *for inserting advertising into a video program comprising:*

*providing a still image from the video program when the video program has been paused* (see at least [0010-0012], [0028-0032]);  
*combining an advertisement image with the still image thereby forming the combined image* (see at least [0010-0012], [0028-0032]); *and*  
*providing the combined image* (see at least [0010-0012], [0028-0032]).

### **Claims 2 and 13**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *waiting a first configurable amount of time after the video program has been paused to provide the combined image* (see at least [0017-0019], [0021]; it is noted that although the insertion is an interactive process the first configurable amount of time could be a predetermined length of advertisement by the content provider at a given location of the video stream; by providing such a predetermined amount of time for the insertion of ads, the video broadcast can proceed as close to real-time as possible).

### **Claims 3 and 14**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *wherein the video program includes audio* (see at least [0010], [0028]).

### **Claims 4 and 15**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses:

*performing a trick function on the video program* (see at least [0030-0032]; e.g., the claimed “trick function” would be to halt delivery of content F1131);

*presenting a new still image from the video program after the trick function has been performed* (see at least [0030-0032]; the claimed “new still image” could be any sequence of video from one frame to a video portion such as one of the different endings of a movies);

*waiting an additional configurable amount of time after the trick function has been performed* (see at least [0030-0032]; the claimed “additional configurable amount of time” would be the length of the video portion added to the stream); *and*

*presenting the combined image after the additional configurable amount of time has passed* (see at least [0030-0032]; the claimed “combined image” would be the movie with the ending chosen by the user).

### **Claims 5 and 16**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *wherein the still image comprises an image from the video program and an additional image* (see at least [0019]; e.g., the claimed “additional image” would be the passive item with a hot button by which a user can request more information; the added hot button is added to the regular broadcast video).

### **Claims 6 and 17**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *wherein the video program continues to play* (see at least [0018]; e.g., streaming of the movies).

### **Claims 7 and 18**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *the additional step of ceasing to provide the combined image* (see at least [0018-0019], [0029-0032]).

### **Claims 8 and 19**

The rejections of base claims 1, 12 and intervening claims 7, 18 are incorporated respectively. Rand further discloses *wherein said ceasing is performed after a second configurable amount of time* (see at least [0018-0019], [0029-0032]).

### **Claims 9 and 20**

The rejections of base claims 1, 12 and intervening claims 7, 18 are incorporated respectively. Rand further discloses *wherein the advertisement image is an advertisement video program and the advertisement video program finishes, before the said ceasing* (see at least [0018-0019], [0029-0032]).

### **Claims 10 and 21**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *wherein a series of advertisement images are provided* (see at least [0012], [0018]).

### **Claims 11 and 22**

The rejections of base claims 1 and 12 are incorporated respectively. Rand further discloses *recording billing information after an advertisement image is provided* (see at least [0022-0027]).

### **Claim 24**

The rejection of base claim 23 is incorporated. Rand further discloses *wherein the stream server comprises: the combiner; VOD content; and advertisement content which provides the combiner with the advertisement image* (see at least FIG. 1).

### **Claim 25**

The rejection of base claim 23 is incorporated. Rand further discloses *wherein the client device comprises: the combiner and advertisement content that provides the combiner with the advertisement image* (see at least FIG. 1 and [0030]; the claimed “combiner” is being equated with Manager 120; the claimed “client device” with STB 110 and the claimed “advertisement content” with content F2132).

### **Claim 26**

The rejection of base claim 23 is incorporated. Rand further discloses *wherein the client device comprises a combiner and a VOD server provides the advertisement image to the combiner* (see at least FIG. 1; the claimed “client device” is being equated with STB 110 which is being shown to include Switch 100, Manager 120, and Monitors 111; the claimed “combiner” is being equated with Manager 120; and the claimed VOD server is being equated with Advertisers 170).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



ANTONY NGUYEN-BA  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100

February 28, 2008